

--8--

REMARKS

Claims 1-8, 10, 32-41, and 52 are currently pending in the application. By this amendment, claims 1, 32, and 52 are amended, claims 9, 11-31, and 42-51 are canceled, and claims 53-56 are added for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided at pages 5 and 17 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Examiner Interview

Applicants appreciate the courtesies extended by the Examiner during the telephonic interview with Applicants' undersigned representative conducted on April 3, 2008. During the interview, the rejection of claims 1, 32, and 52 under 35 U.S.C. §103(a) was discussed. The Examiner indicated that amending independent claims 1, 32, and 52 to recite the feature "partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one of the value, capabilities, and operational resources" would likely be sufficient to overcome the applied reference.

The rejection of claim 32 under 35 U.S.C. §101 was also discussed during the telephonic interview with the Examiner. More specifically, the Examiner suggested that Applicants amend the preamble of claim 32 to include a system comprising hardware and software. The Examiner also suggested Applicants add means language to each of the features of claim 32.

Amendments to the Claims

Applicants have amended claims 1, 32, and 52 and cancelled claims 9, 11-31, and 42-51 from further consideration in this application. Applicants are not conceding in this application that the originally presented claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the examiner. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

Claim Objections

The Examiner has objected to the numbering of claims 1-10. More specifically, the Examiner notes that claim 9 has been omitted. Applicants have canceled claim 9. Accordingly, Applicants respectfully request the claim objection be withdrawn.

35 U.S.C. §112, 2nd Paragraph, Rejection

Claim 52 was rejected under 35 U.S.C. §112, 2nd paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. This rejection is respectfully traversed.

Claim 52 recites, in pertinent part:

A computer program product comprising a computer usable medium having readable program code embodied in the medium, the computer program product includes...

The Examiner asserted it is not clear that the code is tangibly embodied on the computer usable medium. The Examiner further asserted it is not clear whether the claim is directed to software per se or software tangibly embodied on a computer-readable medium.

Applicants submit that MPEP §2111 states that claims should be read in light of the specification and that the specification may be used to interpret limitations explicitly

--10--

recited in the claim. As such, Applicants submit that paragraph [0047] of the specification recites that the present invention may be implemented on "computer program code in combination with the appropriate hardware. This computer program code may be stored on storage media such as a diskette, hard disk, CD-ROM, DVD-ROM or tape, as well as a memory storage device or collection of memory storage devices such as read-only memory (ROM) or random access memory (RAM)." Accordingly, Applicants submit claim 52 is definite and respectfully request the rejection of claim 52 under 35 U.S.C. § 112, 2nd paragraph be withdrawn.

35 U.S.C. §101 Rejection

Claim 32 was rejected under 35 U.S.C. §101 for failing to recite any physical structure that would serve to constitute a system. To advance prosecution, Applicants have amended claim 32 in accordance with the Examiner's suggestions as articulated during the April 3, 2008, Examiner interview. Accordingly, Applicants respectfully request the rejection of claim 32 under 35 U.S.C. §101 be withdrawn.

35 U.S.C. §103 Rejection

Claims 1-10, 32-41, and 52 were rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Publication No. 2003/018800 issued to Pisello, *et al.* ("Pisello") in view of Official Notice. This rejection is respectfully traversed.

In order to reject a claim under 35 U.S.C. §103(a), the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

--11--

reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142.

Independent Claims

To advance prosecution, Applicants have amended independent claims 1, 32, and 52 to include the feature of:

... partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one of the value, capabilities, and operational resources.

Applicants submit this feature is not obvious in view of Pisello. Moreover, Applicants submit this amendment incorporates the language discussed during the Examiner interview on April 3, 2008, wherein the Examiner expressed a belief that the addition of this feature would be sufficient to overcome the applied reference. Accordingly, Applicants respectfully request the rejection of claims 1, 32, and 52 be withdrawn.

Dependent Claims

Applicant submits that claims 2-8, 10, and 33-41 depend from allowable base claims. As such, claims 2-8, 10, and 33-41 include the features of the base claims. Accordingly, Applicants respectfully submit that claims 2-8, 10, and 33-41 include allowable subject matter and that the rejection over claims 2-8, 10, and 33-41 be withdrawn.

--12--

Other Matters

Claims 53-56 are added for the Examiner's consideration. The subject matter of claims 53-56 are allowable by virtue of their dependency on claim 1. Also, no combination of the applied references teach or suggest the features of claims 53-56.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a stylized flourish at the end.

Andrew M. Calderon
Registration No. 38,093

Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
Telephone: 703-716-1191
Facsimile: 703-716-1180